

REMARKS

This Amendment is submitted in reply to the final Office Action mailed on February 3, 2009. A Petition for a one month extension of time is submitted herewith this Amendment. The Commissioner is hereby authorized to charge \$130.00 for the Petition for a one month extension of time and any additional fees that may be required or credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 0112701-00568 on the account statement.

Claims 1-8 and 10-20 are pending in this application. Claim 9 was previously canceled without prejudice or disclaimer. In the Office Action, Claims 1-8, 10-16 and 18-20 are rejected under 35 U.S.C. §102(b). Claims 1-8 and 10-20 are rejected under 35 U.S.C. §103(a). In response, Claims 1 and 20 have been amended and Claims 6-7 have been canceled without prejudice or disclaimer. The amendments do not add new matter. In view of the amendments and/or for at least the reasons set forth below, Applicants respectfully request that the rejections be reconsidered and withdrawn.

In the Office Action, Claims 1-8, 10-16 and 18-20 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,554,400 to Stipp ("*Stipp*"). In contrast, Applicants respectfully submit that *Stipp* is deficient with respect to the present claims.

Currently amended independent Claims 1 and 20 recite, in part, wherein a beverage portioned package contains a water-soluble beverage material in an amount sufficient to form the beverage and a filler; with the filler comprising a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material, wherein the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%. The amendments do not add new matter. The amendments are supported in the Specification at, for example, page 5, line 6-15.

The water-soluble beverage material of the present invention provides the primary beverage ingredient for the beverage which is delivered through an extraction device. See, Specification, page 6, lines 30-33. The portion of water-soluble beverage material is intended to thoroughly mix with water during the extraction. See, Specification, page 7, lines 1-2. The

water-soluble beverage material includes, for example, soluble coffee powder, milk powder, creamer powder, cocoa powder and mixtures thereof. See, Specification, page 7, lines 6-7. The filler maintains a sufficient pressure of extraction while the water-soluble beverage material dissolves in the water passing through the package to release the beverage. See, Specification, page 2, lines 25-28. The filler is configured to decrease the pressure drop during extraction to less than 0.2 bars. See, Specification, page 3, lines 3-6. Maintaining the pressure during extraction ensures that the beverage delivers the desired solids concentration and that a sufficient amount of foam is created. See, Specification, page 2, lines 29-31. A beverage package including such filler thus provides significantly improved properties over beverage packages that do not contain such a filler. See, Specification, page 2, lines 31-32. In view of the amendments and for the reasons set forth below, Applicants respectfully submit that *Stipp* fails to disclose or suggest every element of the present claims.

For example, *Stipp* fails to disclose or suggest a beverage portioned package contains a water-soluble beverage material in an amount sufficient to form the beverage and a filler; with the filler comprising a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material, wherein the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200% as is required, in part, by the present claims. Instead, *Stipp* is entirely directed toward an infusion product for making a beverage, the product having an infusible material and a soluble additive material packaged in an infusion bag. The soluble additive material comprises a co-agglomerate of a creamer base and a sweetener base. See, *Stipp*, Abstract.

In the Office Action, the Patent Office refers to column 9, lines 32-37 of *Stipp* where it is mentioned that the bag is sized to permit movement of the infusion material and the soluble particles. See, Office Action, page 2, lines 20-28. Specifically, *Stipp* discloses that “[t]he bag must be sized to permit movement of the infusion material and soluble additive material particles therein. That is, the material particles must not be so tightly packed in the bag as to restrict free contact between the water and the particles throughout the bag in the preparation of a beverage.” See, *Stipp*, column 9, lines 32-36. Thus, it must follow that *Stipp* is entirely directed toward

avoiding compaction of the particles together and, therefore, there cannot be pressure maintained by the infusion material during extraction. Instead, the bag of *Stipp* is more akin to a tea bag in which materials are loosely placed. Then, when water begins to flow in and dissolves the water soluble coffee, there is even more free place inside and the pressure is not at all maintained. Indeed, *Stipp* even discloses that the bag is “submerged” and “dunk[ed]” in water, as is typical with tea bags.

As such, *Stipp* cannot disclose a package that comprises water-soluble filler that maintains extraction pressure of the beverage during dissolution of the water-soluble beverage material above a certain pressure. Further, *Stipp* fails to even mention that a filler has certain water-absorbent properties, let alone properties that provide a water absorbency rate of a package of at least 200%. Accordingly, *Stipp* fails to disclose or suggest a beverage portioned package contains a water-soluble beverage material in an amount sufficient to form the beverage and a filler; with the filler comprising a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material, wherein the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200% as is required, in part, by the present claims.

Moreover, Applicants also submit that it would not be inherent that the filler of *Stipp* would inherently disclose a filler having water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%. To satisfy the test for inherency, the Patent Office would be required to show that the fillers of *Stipp* necessarily (*i.e.*, always or automatically) provide for a filler having water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%. That condition simply is not met under the present circumstances. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See, MPEP 2112. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993).

For at least the reasons discussed above, Applicants respectfully submit that Claims 1-8, 10-16 and 18-20 are novel, nonobvious and distinguishable from the cited reference.

Accordingly, Applicants respectfully request that the rejections of Claims 1-8, 10-16 and 18-20 under 35 U.S.C. §102(b) be reconsidered and withdrawn.

In the Office Action, Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,554,400 to Stipp ("*Stipp*"). Applicants respectfully submit that the patentability of independent Claim 1 as previously discussed renders moot the obviousness rejection of Claim 17 that depend from Claim 1. In this regard, the cited art fails to teach or suggest the elements of Claim 17 in combination with the novel elements of Claim 1. For at least the reasons discussed above, Applicants respectfully submit that Claim 17 is novel, nonobvious and distinguishable from the cited reference.

Accordingly, Applicants respectfully request that the rejection of Claim 17 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

In the Office Action, Claims 1-8 and 10-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,110,732 to Kane ("*Kane*") in view of U.S. Patent No. 6,777,007 to Cai ("*Cai*"). In contrast, Applicants respectfully submit that the cited references are deficient with respect to the present claims.

As discussed above, currently amended independent Claims 1 and 20 recite, in part, wherein a beverage portioned package contains a water-soluble beverage material in an amount sufficient to form the beverage and a filler; with the filler comprising a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material, wherein the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%. The filler is configured to decrease the pressure drop during extraction to less than 0.2 bars. See, Specification, page 3, lines 3-6. Maintaining the pressure during extraction ensures that the beverage delivers the desired solids concentration and that a sufficient amount of foam is created. See, Specification, page 2, lines 29-31. A beverage package including such filler thus provides significantly improved properties over beverage packages that do not contain such a filler. See, Specification, page 2, lines 31-32. In view of the amendments and for the reasons set forth below, Applicants

respectfully submit that *Kane* and *Cai* fail to disclose or suggest every element of the present claims.

For example, *Kane* and *Cai* both fail to disclose or suggest a beverage portioned package contains a water-soluble beverage material in an amount sufficient to form the beverage and a filler; with the filler comprising a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material, wherein the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200% as is required, in part, by the present claims. Instead, *Kane* is entirely directed toward coffee balls that comprise a relatively small bag or sack made of gauze or open-mesh fabric that contains a charge of dry, soluble coffee product and a requisite amount of coarsely crushed, roasted coffee having a grain size larger than the meshes of the gauze or fabric. See, *Kane*, column 2, lines 37-42. Thus, the water in *Kane* flows into the coffee ball through all of the surfaces of the coffee ball and the beverage flows out through all of the surfaces of the coffee ball as well. This is in direct contrast to the present invention wherein the package includes a first surface for flowing water in the package and a second, different, surface for flowing the beverage out.

Further, *Kane* deals exclusively with the problem of improving the taste of a coffee beverage produced from soluble coffee by adding fresh coffee particles to the soluble coffee. At no point in the disclosure does *Kane* even disclose or suggest that the water is introduced into the package under pressure. Indeed, the coffee balls of *Kane* are also akin to tea bags and *Kane* explicitly discloses that it is preferred to “place the ball in the bottom of a cup and pour boiling water having a [certain temperature] over the same.” See, *Kane*, page 2, column 2, lines 11-14.

Accordingly, the coffee balls of *Kane* are entirely distinguishable from the packages of the present invention and *Kane* fails to disclose or suggest a beverage portioned package contains a water-soluble beverage material in an amount sufficient to form the beverage and a filler; with the filler comprising a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second

surfaces when the package is emptied of the water-soluble material, wherein the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200% as is required, in part, by the present claims.

Cai is entirely directed toward a pod for making coffee wherein the flavor-containing material is sandwiched between two porous sheets. However, at no place in the disclosure does *Cai* disclose or even suggest that a filler maintains extraction pressure of the beverage during dissolution of the water-soluble beverage material above a certain pressure. *Cai* also fails to disclose or even suggest that the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%. Instead, *Cai* would teach the skilled artisan that, if insoluble coffee particles and soluble coffee were mixed in a pod to improve the taste of the soluble coffee in the pods, these two materials should be placed in two separate layers as is disclosed in *Cai* at column 9, line 42-column 10, line 9.

Accordingly, *Cai* fails to disclose or suggest a beverage portioned package contains a water-soluble beverage material in an amount sufficient to form the beverage and a filler; with the filler comprising a water insoluble and water-absorbent material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material, wherein the filler has water-absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200% as is required, in part, by the present claims. For at least the reasons discussed above, Applicants respectfully submit that Claims 1-8 and 10-20 are novel, nonobvious and distinguishable from the cited reference.

Accordingly, Applicants respectfully request that the rejection of Claims 1-8 and 10-20 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

In response to the Patent Office's assertion that Applicants have addressed the references individually and not as a combination of references, see, Office Action, page 8, lines 6-9, Applicants respectfully submit that, to the extent that the references are discussed individually, it is not to address the rejections as anticipation rejections, but rather to point out the deficiencies of the cited references. In this case, the cited references fail to disclose each and every element of the present claims.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

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